

REMARKS

Claims 1-24 were pending. Claims 1-24 are rejected under 35 U.S.C. §112, second paragraph. Claims 16, 18-19, 21-22 and 24 are rejected under 35 U.S.C. §102(e). Claims 1-15 and 17, 20 and 23 are rejected under 35 U.S.C. §103(a).

Applicants cancelled claims 16, 19 and 22 without prejudice or disclaimer and reserve the right to file a continuation patent application to capture the subject matter of cancelled claims 16, 19 and 22. As a result of canceling claims 16, 19 and 22, claims 1-15, 17-18, 20-21 and 23-24 are pending in the Application.

Applicants amended claims 17, 20 and 23 to be rewritten in independent form. Applicants amended claims 18, 21 and 24 to be dependent upon claims 17, 20 and 23 instead of claims 16, 19 and 22, respectively, due to the cancellation of claims 16, 19 and 22.

Applicants note that claims 17, 20 and 23 were not amended to overcome prior art but to be rewritten in independent form. Applicants further note that claims 18, 21 and 24 were not amended to overcome prior art but to be rewritten in order to not depend from cancelled claims. Hence, no prosecution history estoppel arises from the amendments to claims 17-18, 20-23 and 23-24. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 62 U.S.P.Q.2d 1705, 1711-12 (2002); 56 U.S.P.Q.2d 1865, 1870 (Fed. Cir. 2000). Further, the amendments made to claims 17-18, 20-23 and 23-24 were not made for a substantial reason related to patentability and therefore no prosecution history estoppel arises from such amendments. *See Festo Corp.*, 62 U.S.P.Q.2d 1705 at 1707 (2002); *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 41 U.S.P.Q.2d 1865, 1873 (1997).

Applicants respond to the rejections indicated above as follows.

I. REJECTIONS UNDER 35 U.S.C. §112, SECOND PARAGRAPH:

The Examiner has rejected claims 1-15, 17-18, 20-21 and 23-24 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Office Action (1/30/2006), page 2. In particular, the Examiner rejects claims 1, 6, 11 for the use of the term "approximately" and rejects claims 16, 19 and 22<sup>1</sup> for the use of the term "approximate." Office Action (1/30/2006), page 2. The Examiner states:

The terms 'approximately' and 'approximate' are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Office Action (1/30/2006), page 2.

Applicants respectfully traverse.

Applicants respectfully assert that claims 1-15, 17-18, 20-21 and 23-24 set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. In particular, Applicants respectfully assert that the terms "approximately" and "approximate" are clearly understood. "Approximately," as defined by Merriam-Webster, means "nearly correct or exact." See <http://www.m-w.com/dictionary/approximate>. Further, "approximate," as defined by Merriam-Webster, means "to come near to or be close to in position, value, or characteristics." See Merriam-Webster's Collegiate Dictionary, Tenth Edition, © 1999. Hence, the phrase "where the broadcast is interpreted by users located approximately within a defined distribution area of the broadcaster," as recited in claims 1, 6 and 11 may refer to where the broadcast is interpreted by users that are located nearly exactly within a defined distribution area of the broadcaster. Further, the phrase "determining an approximate physical location of said requester," as recited in claims 17, 20 and 23<sup>2</sup>, may refer to determining a location that is close to the physical location of the requester. Further, the phrase "transmitting said broadcast over the Internet to said request if said requester is physically located approximately within said defined distribution area" as recited in claims 17, 20 and 23, may refer to transmitting a broadcast over the Internet to the requester if the requester is physically located nearly exactly within a defined distribution area of the broadcaster. Thus, the scope

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<sup>1</sup> Claims 16, 19, and 22 were cancelled but the limitations of claims 16, 19 and 22 were incorporated in claims 17, 20 and 23, respectively. Consequently, Applicants address the rejections to claims 16, 19 and 22 under 35 U.S.C. §112, second paragraph, in connection with claims 17, 20 and 23.

of claims 1-15, 17-18, 20-21 and 23-24 would be clear to a hypothetical person possessing the ordinary level of skill in the pertinent art. According to M.P.E.P. §2171, a claim particularly points out and distinctly defines the metes and bounds of the subject matter if the scope of the claim is clear to a hypothetical person possessing the ordinary level of skill in the pertinent art. Hence, claims 1-15, 17-18, 20-21 and 23-24 particularly points out and distinctly defines the metes and bounds of the subject matter. Consequently, Applicants respectfully assert that claims 1-15, 17-18, 20-21 and 23-24 are allowable under 35 U.S.C. §112, second paragraph, and respectfully request the Examiner to withdraw the rejections of claims 1-15, 17-18, 20-21 and 23-24 under 35 U.S.C. §112, second paragraph. M.P.E.P. §2171.

Further, not defining a term in the claims or in the Specification is not by itself sufficient grounds for rejecting those claims under 35 U.S.C. §112, second paragraph. A claim term that is not used or defined in the Specification is not indefinite if the meaning of the claim term is discernible. *Bancorp Services, L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1372, 69 U.S.P.Q.2d 1996, 1999-2000 (Fed. Cir. 2000). As shown above, the meaning of claims 1-15, 17-18, 20-21 and 23-24 are discernible and hence claims 1-15, 17-18, 20-21 and 23-24 are allowable under 35 U.S.C. §112, second paragraph. Applicants respectfully request the Examiner to withdraw the rejections of claims 1-15, 17-18, 20-21 and 23-24 under 35 U.S.C. §112, second paragraph. M.P.E.P. §2171.

Further, if the Examiner is rejecting claims 1-15, 17-18, 20-21 and 23-24 for the simple reason that they use the terms "approximate" and "approximately," then the Examiner has improperly rejected claims 1-15, 17-18, 20-21 and 23-24 under 35 U.S.C. §112, second paragraph. Applicants identified 187,274 patents on the USPTO website that were issued since 1976 that used the term "approximately" in the claims. Further, Applicants identified 17,577 patents on the USPTO website that were issued since 1976 that used the term "approximate" in the claims. Clearly the use of these terms in claims is common and the use of these terms cannot be the sole reason or rationale for rejecting claims 1-15, 17-18, 20-21 and 23-24 under 35 U.S.C. §112, second paragraph. Otherwise, there would be several tens of thousands of patents that are invalid for having indefinite claims. Applicants

respectfully request the Examiner to withdraw the rejections of claims 1-15, 17-18, 20-21 and 23-24 under 35 U.S.C. §112, second paragraph. M.P.E.P. §2171.

Further, the Examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. §112, second paragraph, should be whether the claim meets the threshold requirement of clarity and precision, not whether more suitable language or modes of expression are available. M.P.E.P. §2173.02. Definiteness of claim language must be analyzed, not in a vacuum, but in light of the content of the particular application disclosure; the teachings of the prior art; and the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. M.P.E.P. §2173.02. In reviewing a claim for compliance with 35 U.S.C. §112, second paragraph, the Examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. §112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent. *See, e.g., Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 U.S.P.Q.2d 1279, 1283 (Fed. Cir. 2000); M.P.E.P. §2173.02. As shown above, the scope of claims 1-15, 17-18, 20-21 and 23-24 and in particular the limitations involving the term "approximately" or "approximate," when analyzed in light of the Specification, can be determined by one of ordinary skill in the art and therefore serves the notice function required by 35 U.S.C. §112, second paragraph. Consequently, Applicants respectfully assert that claims 1-15, 17-18, 20-21 and 23-24 are allowable under 35 U.S.C. §112, second paragraph, and respectfully request the Examiner to withdraw the rejections of claims 1-15, 17-18, 20-21 and 23-24 under 35 U.S.C. §112, second paragraph.

The Examiner further rejects claims 17, 20 and 23 under 35 U.S.C. §112, second paragraph, for not including the term "address" following the phrase "Internet Protocol." Applicants amended claims 17, 20 and 23, as indicated above, by including the term "address" following the phrase "Internet Protocol." Consequently, Applicants respectfully assert that claims 1-15, 17-18, 20-21 and 23-24 are allowable

under 35 U.S.C. §112, second paragraph, and respectfully request the Examiner to withdraw the rejections of claims 1-15, 17-18, 20-21 and 23-24 under 35 U.S.C. §112, second paragraph.

II. REJECTIONS UNDER 35 U.S.C. §102(e):

The Examiner rejects claims 16, 18-19, 21-22 and 24 under 35 U.S.C. §102(e) as being anticipated by Franken et al. (U.S. Publication No. 2003/0097654) (hereinafter "Franken"). The rejections to claims 16, 19 and 22 are moot as Applicants cancelled claims 16, 19 and 22. Further, the rejections to claims 18, 21 and 24 are moot as claims 18, 21 and 24 were amended to be dependent upon claims 17, 20 and 23 which are rejected under 35 U.S.C. §103(a) as being unpatentable over Franken in view of Schlossberg et al. (U.S. Publication No. 2002/0066034).

III. REJECTIONS UNDER 35 U.S.C. §103(a):

The Examiner rejects claims 1-15 under 35 U.S.C. §103(a) as being unpatentable over Pezzillo et al. (U.S. Patent No. 6,434,621) (hereinafter "Pezzillo") in view of Teare et al. (U.S. Patent No. 5,243,652) (hereinafter "Teare"). The Examiner further rejects claims 17, 20 and 23 under 35 U.S.C. §103(a) as being unpatentable over Franken in view of Schlossberg et al. (U.S. Publication No. 2002/0066034) (hereinafter "Schlossberg"). Applicants respectfully traverse these rejections for at least the reasons stated below and respectfully request the Examiner to reconsider and withdraw these rejections.

A. Pezzillo and Teare, taken singly or in combination, do not teach or suggest the following claim limitations.

Applicants respectfully assert that Pezzillo and Teare, taken singly or in combination, do not teach or suggest "transmitting said encrypted digital packets of information over the Internet" as recited in claim 1 and similarly in claims 6 and 11. The Examiner has not fully addressed this limitation. The Examiner simply cites column 5, lines 60-67 of Pezzillo as teaching transmitting digital packets of information over the Internet. Office Action (1/30/2006), page 5. However, the claim limitation recites transmitting the encrypted digital packets of information over the Internet. Therefore, the Examiner has not presented a *prima facie* case of

obviousness in rejecting claims 1, 6 and 11, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Pezzillo and Teare, taken singly or in combination, do not teach or suggest "encrypting said digital packets of information" as recited in claim 1 and similarly in claims 6 and 11. The Examiner cites column 2, lines 11-63 of Teare as teaching the above-cited claim limitation. Office Action (1/30/2006), page 5. Applicants respectfully traverse and assert that Teare instead teaches a mobile unit (e.g., aircraft) that store encrypted signals. Column 2, lines 11-12. Teare further teaches the mobile unit (e.g., aircraft) transmitting the encrypted signals (e.g., in-flight entertainment) to a central facility which may authorize the viewing of the encrypted video signal on an airplane if the airplane is over 25,000 ft. altitude and over a pre-designated area. Column 2, lines 12-49. There is no language in the cited passage that teaches encrypting digital packets of information. Instead, Teare teaches the storage and transfer of encrypted signals. Teare does not specifically teach in the cited passage the actual encryption of the signals. . Neither is there any language in the cited passage that teaches encrypting digital packets of information in which a radio broadcast was encoded into the digital packets of information. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 1, 6 and 11, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Pezzillo and Teare, taken singly or in combination, do not teach or suggest "providing a decryption key to a transmitter to be broadcasted within said defined distribution area of said broadcaster" as recited in claim 1 and similarly in claims 6 and 11. The Examiner cites column 2, lines 11-63 of Teare as teaching the above-cited claim limitation. Office Action (1/30/2006), page 5. Applicants respectfully traverse and assert that Teare instead teaches a mobile unit (e.g., aircraft) that store encrypted signals. Column 2, lines 11-12. Teare further teaches the mobile unit (e.g., aircraft) transmitting the encrypted signals (e.g., in-flight entertainment) to a central facility which may authorize the viewing of the

encrypted video signal on an airplane if the airplane is over 25,000 ft. altitude and over a pre-designated area. Column 2, lines 12-49. There is no language in the cited passage that teaches providing a decryption key to a transmitter. Neither is there any language in the cited passage that teaches providing a decryption key to a transmitter to be broadcasted within a defined distribution area of a broadcaster. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 1, 6 and 11, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Claims 2-5, 7-10 and 12-15 each recite combinations of features including the above combinations, and thus are patentable over Pezzillo in view of Teare for at least the above-stated reasons. Claims 2-5, 7-10 and 12-15 recite additional features, which, in combination with the features of the claims upon which they depend, are patentable over Pezzillo in view of Teare.

For example, Pezzillo and Teare, taken singly or in combination, do not teach or suggest "receiving said decryption key by one or more users of computer systems located approximately within said defined distribution area of said broadcaster" as recited in claim 2 and similarly in claims 7 and 12. The Examiner cites column 2, lines 11-63 of Teare as teaching the above-cited claim limitation. Office Action (1/30/2006), page 5. Applicants respectfully traverse. As stated above, Teare instead teaches a mobile unit (e.g., aircraft) that store encrypted signals. Column 2, lines 11-12. Teare further teaches the mobile unit (e.g., aircraft) transmitting the encrypted signals (e.g., in-flight entertainment) to a central facility which may authorize the viewing of the encrypted video signal on an airplane if the airplane is over 25,000 ft. altitude and over a pre-designated area. Column 2, lines 12-49. There is no language in the cited passage that teaches receiving a decryption key. Neither is there any language in the cited passage that teaches receiving a decryption key by one or more users of computer systems. Neither is there any language in the cited passage that teaches receiving a decryption key by one or more users of computer systems located approximately within a defined distribution area of a broadcaster. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 2, 7

and 12, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Pezzillo and Teare, taken singly or in combination, do not teach or suggest "decrypting said encrypted digital packets of information using said decryption key" as recited in claim 3 and similarly in claims 8 and 13. The Examiner cites "Glick et al. paragraph 119." Office Action (1/30/2006), page 6. Applicants are confused as to the citing of Glick et al. when the Examiner previously states that claims 3, 8 and 13 are rejected in light of Pezzillo in view of Teare. Applicants respectfully request the Examiner to clarify the rejection of claims 3, 8 and 13 pursuant to 37 C.F.R. §1.104(c)(2). Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 3, 8 and 13, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Pezzillo and Teare, taken singly or in combination, do not teach or suggest "wherein said decryption key is transmitted via electromagnetic waves within said defined distribution area of said broadcaster" as recited in claim 5 and similarly in claims 10 and 15. The Examiner cites column 2, lines 11-63 of Teare as teaching the above-cited claim limitation. Office Action (1/30/2006), page 6. Applicants respectfully traverse. As stated above, Teare instead teaches a mobile unit (e.g., aircraft) that store encrypted signals. Column 2, lines 11-12. Teare further teaches the mobile unit (e.g., aircraft) transmitting the encrypted signals (e.g., in-flight entertainment) to a central facility which may authorize the viewing of the encrypted video signal on an airplane if the airplane is over 25,000 ft. altitude and over a pre-designated area. Column 2, lines 12-49. There is no language in the cited passage that teaches a transmitting a decryption key. Neither is there any language in the cited passage that teaches transmitting a decryption key via electromagnetic waves within a defined distribution area of a broadcaster. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 5, 10 and 15, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).



As a result of the foregoing, Applicants respectfully assert that there are numerous claim limitations not taught or suggested in Pezzillo in view of Teare, and thus the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 1-15. M.P.E.P. §2143.

B. Applicants traverse the Examiner's taking of Official Notice with respect to claims 4, 9 and 14.

Applicants respectfully assert that Pezzillo and Teare, taken singly or in combination, do not teach or suggest "reproducing said decrypted digital broadcast by an audio transducer" as recited in claim 4 and similarly in claims 9 and 14. The Examiner takes Official Notice that it would have been obvious to a person of ordinary skill in the art to use an audio transducer to reproduce the digital broadcast. Office Action (1/30/2006), page 6. The Examiner's motivation is to allow the receiver to hear the digital broadcast. Office Action (1/30/2006), page 6.

Applicants respectfully traverse the implied assertion that it would have been obvious to one of ordinary skill in the art to modify Pezzillo in view of Teare to reproduce a decrypted digital broadcast by an audio transducer. Applicants respectfully request the Examiner to provide a reference that teaches reproducing a decrypted digital broadcast by an audio transducer pursuant to M.P.E.P. §2144.03. Furthermore, the Examiner is reminded that in order to establish a *prima facie* case of obviousness the Examiner must provide some suggestion or motivation, either in the references themselves, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved, to modify the reference or to combine reference teachings. *See In re Dembiczak*, 175 F.3d 1994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). The Examiner states "to allow the receiver to hear the digital broadcast" as motivation. However, the Examiner has not provided any evidence that his motivation comes from any of the sources listed above. Instead, the Examiner is relying upon his own subjective opinion which is insufficient to support a *prima facie* case of obviousness. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Consequently, the Examiner's motivation is insufficient to support a *prima facie* case of obviousness for rejecting claims 4, 9 and 14. *Id.*

C. Examiner Relies on a Reference Under 35 U.S.C. §103 that is not Analogous Prior Art.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art, and all teachings in the prior art must be considered to the extent that they are in analogous arts. M.P.E.P. §2143.01. In order to rely on a reference as a basis for rejection under 35 U.S.C. §103(a), the reference must either be in the field of Applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 977 F.2d 1443, 1446, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992). The Examiner cites the Pezzillo and Teare references in his rejection of claims 1-15 under 35 U.S.C. §103(a). The Teare reference addresses the problem of transmitting geo-graphical information in a secured manner over remote or mobile systems without require secure facilities for the remote or mobile node. Column 1, lines 23-37. Applicants, on the other hand, address the problem of enabling broadcasters to transmit information over the Internet to a smaller distribution base of listeners thereby lessening the amount of copyright royalty fees the broadcaster may be required to pay. Specification, page 2, lines 10-13. Hence, the Teare reference is not in the same field as Applicants' endeavor and is not reasonably pertinent to solving the problem of enabling broadcasters to transmit information over the Internet to a smaller distribution base of listeners thereby lessening the amount of copyright royalty fees the broadcaster may be required to pay. As a result, the Teare reference is not an analogous prior art and the Examiner has not established a *prima facie* case of obviousness in rejecting claims 1-15. M.P.E.P. §2141.01; 2143.01.

D. The Examiner's motivation in modifying Pezzillo to incorporate the limitations of claims 1, 6 and 11 is insufficient to establish a *prima facie* case of obviousness in rejecting claims 1-15.

Most if not all inventions arise from a combination of old elements. *See In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the

patent pertains. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Therefore, an Examiner may often find every element of a claimed invention may often be found in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See Id.* In order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). That is, the Examiner must provide some suggestion or motivation, either in the references themselves, the knowledge of one of ordinary skill in the art, or, in some case, the nature of the problem to be solved, to modify the reference or to combine reference teachings. *See In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Whether the Examiner relies on an express or an implicit showing, the Examiner must provide particular findings related thereto. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

The Examiner admits that Pezzillo does not teach encrypting the digital packets of information; and providing a decryption key to a transmitter to be broadcasted within the defined distribution area of the broadcast, as recited in claim 1 and similarly in claims 6 and 11. Office Action (1/30/2006), page 5. The Examiner's motivation for modifying Pezzillo with Teare to include the above-cited claim limitations is "to provide location-sensitive control over remote or mobile systems in a secure manner, without requiring secure facilities for the remote or mobile node (see column 1, lines 34-37)." Office Action (1/30/2006), page 5. The Examiner's motivation is insufficient to support a *prima facie* case of obviousness for at least the reasons stated below.

The Examiner's motivation does not provide reasons, as discussed further below, that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Pezzillo to include the above-cited missing claim limitation from claims 1, 6 and 11. According, the

Examiner has not presented a *prima facie* case of obviousness for rejecting claims 1-15. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

Pezzillo address the problem of overriding an Internet station's program schedule and forcing a show or live event to occur at a specific time in the future as well as an automating DMCA/SRPC compliance and reporting method for Internet broadcasting and automatically controlling advertising inserts. Column 2, line 64 – column 3, line 7. The Examiner has not provided any reasons as to why one skilled in the art would modify Pezzillo, which overcomes the above-mentioned problems by enabling Internet or intranet broadcasting that offers audio automation and webcast automation (Abstract), to encrypt the digital packets of information and to provide a decryption key to a transmitter to be broadcasted within the defined distribution area of the broadcast (Examiner admits that Pezzillo does not teach these limitations). As stated above, the Examiner's motivation is to provide location-sensitive control over remote or mobile systems (e.g., aircraft) in a secure manner, without requiring secure facilities for the remote or mobile node (source of Examiner's motivation at column 1, lines 34-37 of Teare). This does not provide reasons as to why one skilled in the art would modify Pezzillo, whose purpose is to enable Internet or intranet broadcasting that offers audio automation and webcast automation, to encrypt the digital packets of information and to provide a decryption key to a transmitter to be broadcasted within the defined distribution area of the broadcast. Further, the Examiner has not provided any rationale connection between providing location-sensitive control over remote or mobile systems (e.g., aircraft) in a secure manner, without requiring secure facilities for the remote or mobile node (Examiner's motivation) and encrypting the digital packets of information and providing a decryption key to a transmitter to be broadcasted within the defined distribution area of the broadcast (missing claim limitations). The Examiner must provide objective evidence in modifying Franken to include the above-cited missing limitation of claims 1, 6 and 11. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Instead, the Examiner is merely relying upon his own subjective opinion which is insufficient to support a *prima facie* case of obviousness in rejecting claims 1-15. *Id.* Consequently, the Examiner's motivation is insufficient to support a *prima facie* case of obviousness for rejecting claims 1-15. *Id.*

- E. Examiner has not provide motivation for modifying Pezzillo to include the limitations of claims 2-3, 5, 7-8, 10, 12-13 and 15.

In order to establish a *prima facie* case of obviousness, the Examiner must submit some suggestion or motivation to modify the reference to combine reference teachings. M.P.E.P. §2143. The Examiner admits that Pezzillo does not teach the limitations of claims 2-3, 5, 7-8, 10, 12-13 and 15. Office Action (1/30/2006), pages 5-6. The Examiner modifies Pezzillo with either Glick or Teare to include the missing claim limitations of claims 2-3, 5, 7-8, 10, 12-13 and 15. Office Action (1/30/2006), pages 5-6. However, the Examiner fails to present any motivation for modifying Pezzillo to include the missing claim limitations of claims 2-3, 5, 7-8, 10, 12-13 and 15. Hence, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 2-3, 5, 7-8, 10, 12-13 and 15. M.P.E.P. §2143.

- F. The Examiner's motivation is insufficient to establish a *prima facie* case of obviousness in rejecting claims 17-18, 20-21 and 23-24.

As stated above, in order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). That is, the Examiner must provide some suggestion or motivation, either in the references themselves, the knowledge of one of ordinary skill in the art, or, in some case, the nature of the problem to be solved, to modify the reference or to combine reference teachings. *See In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Whether the Examiner relies on an express or an implicit showing, the Examiner must provide particular findings related thereto. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

The Examiner admits that Franken does not teach capturing an Internet Protocol address of the requester; converting the captured Internet Protocol of the requester into a computer name; and performing a trace of the request, as recited in claims 17, 20 and 23. Office Action (1/30/2006), pages 6-7. The Examiner's

motivation for modifying Franken with Schlossberg to include the above-cited claim limitations is "to determine the physical location of a device on the Internet (see paragraph 54)." Office Action (1/30/2006), page 7. The Examiner's motivation is insufficient to support a *prima facie* case of obviousness for at least the reasons stated below.

The Examiner's motivation does not provide reasons, as discussed further below, that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Franken to include the above-cited missing claim limitation from claims 17, 20 and 23. According, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 17-18, 20-21 and 23-24. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

As stated above, the Examiner cites [0054] of Schlossberg as the source of the Examiner's motivation. Schlossberg teaches that the reconnaissance unit (element 117) notifies the owner of the security system and generates a detailed report to the network security personnel with information, such as the MAC/IP address the attacker is using, the attacker's machine DNS name, the attacker's physical location, and other pertinent information. [0054]. Hence, [0054] of Schlossberg teaches using a reconnaissance unit to identify attackers such as obtaining the IP address the attacker is using. Thus, the Examiner's statement that [0054] of Schlossberg teaches the motivation for determining the physical location of a device on the Internet is not complete. [0054] of Schlossberg teaches the motivation of using a reconnaissance unit to identify attackers such as obtaining the IP address the attacker is using.

Franken addresses the problem of delivering television and radio programming via the Internet while taking into consideration the well-established territorial restrictions. [0005]-[0007]. The Examiner has not provided any reasons as to why one skilled in the art would modify Franken, which overcomes the above-mentioned problem by utilizing an authorization scheme based upon numerous criteria, including a signal strength calculator, a distance from a point calculator, and a GIS boundary computer (Abstract), to capture an Internet Protocol address of the

requester; to convert the captured Internet Protocol of the requester into a computer name; and to perform a trace of the request (Examiner admits that Franken does not teach this limitation). As stated above, the Examiner's source of motivation ([0054] of Schlossberg) teaches using a reconnaissance unit to identify attackers such as obtaining the IP address the attacker is using. This does not provide reasons as to why one skilled in the art would modify Franken, whose purpose is to utilize an authorization scheme based upon numerous criteria, including a signal strength calculator, a distance from a point calculator, and a GIS boundary computer, to capture an Internet Protocol address of the requester; to convert the captured Internet Protocol of the requester into a computer name; and to perform a trace of the request. Further, the Examiner has not provided any rationale connection between using a reconnaissance unit to identify attackers such as obtaining the IP address the attacker is using (Examiner's motivation) and capturing an Internet Protocol address of the requester; converting the captured Internet Protocol of the requester into a computer name; and performing a trace of the request (missing claim limitations). The Examiner must provide objective evidence in modifying Franken to include the above-cited missing limitation of claims 17, 20 and 23. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Instead, the Examiner is merely relying upon his own subjective opinion which is insufficient to support a *prima facie* case of obviousness in rejecting claims 17-18, 20-21 and 23-24. *Id.* Consequently, the Examiner's motivation is insufficient to support a *prima facie* case of obviousness for rejecting claims 17-18, 20-21 and 23-24. *Id.*

IV. CONCLUSION:

As a result of the foregoing, it is asserted by Applicants that claims 1-15, 17-18, 20-21 and 23-24 in the Application are in condition for allowance, and Applicants respectfully request an allowance of such claims. Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Respectfully submitted,

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